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From : Stephen E. Reiter <i>SR</i>
Email Address : sreiter@foley.com
Sender's Direct Dial : 858.847.6711
Date : February 28, 2005
Client/Matter No : SALK3130-1 (088802-9702)
User ID No : 1877

MESSAGE:

Re: U.S. Patent Application No. 10/658,115

Following are:

- 1) Request for Reconsideration of Decision Dismissing Petition Under 37 CFR 1.47(a) (2 pgs.)
- 2) Declaration of Facts in Support of Petition Under 37 C.F.R. § 1.47 (2 pgs.)
- 3) Copy of letter dated April 6, 2004 (2 pgs.)

If there are any problems with this transmission or if you have not
received all of the pages, please call 858.847.6700.

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Atty. Dkt. No.SALK3130-1 (088802-9702)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Downes et al.

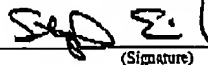
Title: NON-STEROIDAL FARNESOID
X RECEPTOR MODULATORS
AND METHODS FOR THE USE
THEREFOR

Appl. No.: 10/658,115

Filing Date: 09/08/2003

Examiner: Unknown

Art Unit: 1645

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.
<u>Stephen E. Reiter, Reg. No. 31,192</u> (Printed Name)
<u></u> (Signature)
<u>February 28, 2005</u> (Date of Deposit)

**REQUEST FOR RECONSIDERATION OF DECISION DISMISSING
PETITION UNDER 37 CFR 1.47(a)**Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RECEIVED
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FEB 28 2005

Attention: E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

Sir:

Applicants hereby request reconsideration of the Decision Refusing Status Under 37 C.F.R. 1.47(a) mailed December 30, 2004. Specifically, Applicants hereby submit a supplemental Declaration of Facts in Support of Petition Under 37 C.F.R § 1.47, along with a copy of the letter from counsel for the non-signing inventors (dated April 6, 2004) stating that "[w]e are not able to provide the signed documents requested. . ."

As detailed in the attached supplemental Declaration of Facts in Support of Petition Under 37 C.F.R § 1.47 from Attorney Sheila R. Kirschenbaum, in-house counsel for Applicants Downes and Evans, a copy of the application as filed and the formal papers for signature were

In re application of
Downes et al.
Application No.: 10/658,115
Page 2 of 2

Atty. Dkt. No.SALK3130-1 (088802-9702)

separately provided for signature to Attorney Thomas Fitting, the legal representative for inventors Robert Hughes, K.C. Nicolau and Anthony J. Roecker. However, in a letter to Attorney Kirschenbaum's assistant (Ms. Judith Best) dated April 6, 2004 (copy attached to the Declaration), while acknowledging receipt of the letter dated January 29, 2004, from The Salk Institute for Biological Studies, Dr. Fitting advised that the Declaration for Patent Application would not be signed by the inventors (see the second paragraph of the subject letter). Thus, in spite of Applicants' repeated request for return of the executed documents, no reply has been received from any of inventors Robert Hughes, K.C. Nicolau and Anthony J. Roecker.

Based on the foregoing, it is submitted that Applicants have satisfied the requirements of 37 C.F.R. §1.47(a).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Respectfully submitted,

Date 2/28/05
FOLEY & LARDNER LLP
Customer Number: 30542
Telephone: (858) 847-6711
Facsimile: (858) 792-6773

By SEP
Stephen E. Reiter
Attorney for Applicant
Registration No. 31,192

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PATENT
Attorney Docket No.: SALK3130-1
(088802-9702)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Downes et al.

Group Art Unit: 1645

Application No.: 10/658,115

Examiner: Unknown

Filing Date: September 8, 2003

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile transmitted to the
United States Patent and Trademark Office, Washington, D.C., on
the date below.

For: NON-STEROIDAL FARNESOID X
RECEPTOR MODULATORS AND
METHODS FOR THE USE THEREFOR

Stephan E. Reiter

Printed Name

SEP 8 L 3/28/05

Signature

Date

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

DECLARATION OF FACTS IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47

I, Sheila R. Kirschenbaum, declare that:

1. I, Sheila R. Kirschenbaum am Patent Counsel to Applicant, the Salk Institute for Biological Studies located in La Jolla, CA.
2. Inventors Michael Downes and Ronald Evans were employed by the Salk Institute for Biological Studies at the time of conception of the invention. A Declaration by Inventor, executed by Drs. Downes and Evans was submitted on June 23, 2004 to the United States Patent and Trademark Office.
3. Inventors Robert Hughes, K.C. Nicolaou and Anthony J. Roecker were employed by The Scripps Research Institute located in La Jolla, CA at the time of conception of the invention.

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Application No.: 10/658,115
Filing Date: September 8, 2003
Page 2

PATENT
Attorney Docket No.: SALK3130-1
(088802-9702)

4. Thomas Fitting, Esq., Ph.D. is Chief Patent Counsel to The Scripps Research Institute, and is the legal representative of Messrs. Hughes, Nicolaou and Roecker with respect to patent matters.

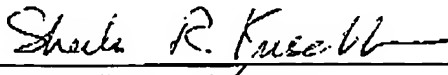
5. A Declaration by Inventor for signature by Messrs. Hughes, Nicolaou and Roecker in United States Application No. 10/658,115 along with copies of the application were sent to Dr. Fitting, Esq. via U.S. Postal Service on January 29, 2004. Dr. Fitting, as legal representative of Messrs. Hughes, Nicolaou and Roecker, was informed in an accompanying letter of the requirement that each inventor named on United States Application No. 10/658,115, including Messrs. Hughes, Nicolaou and Roecker, execute a Declaration by Inventor.

6. No Declaration in United States Application No. 10/658,115, signed by Messrs. Hughes Nicolaou or Roecker was received in response to the request described in point 3.

7. Dr. Fitting, Esq., in a letter dated April 6, 2004 (a copy of which is attached herewith as Exhibit A), acknowledged receipt of Salk's letter dated January 29, 2004 requesting signatures on a Declaration by Inventors (see first paragraph). Dr. Fitting, Esq. informed Salk that he would not provide Salk with the requested executed Declaration by Inventors (see second paragraph).

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date 10 February 2005



Sheila R. Kirschenbaum
Patent Counsel,
The Salk Institute

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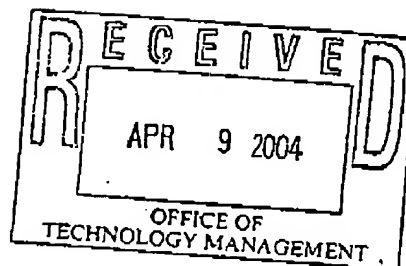
FEB 28 2005

Thomas Fitting, Esq., Ph.D.
Chief Patent Counsel

10550 North Torrey Pines Road
La Jolla, California 92037
mail TPC-8
tel 858 784 2937
fax 858 784 9399
e-mail: fitting@scripps.edu

April 6, 2004

Ms. Judith A. Best
The Salk Institute
10010 N. Torrey Pines Road
La Jolla, CA 92037



Re: U.S. Patent Application No. 10/658,115, and *Sealed*
International Patent Application No. US03/36123 *Sealed*
TSRI Case No. 918.0P

Dear Ms. Best:

I have received your letter dated January 29, 2004, regarding the above-identified patent applications. In that letter you request that we obtain and provide signed formal documents in support of these applications, including Inventors' Declarations, Assignments and Power of Attorney documents.

We are not able to provide the signed documents requested because we are currently in disagreement with the Salk Institute regarding inventorship on the subject matter of the above-identified US application. Further, for the PCT application we cannot sign at least because we do not know what is being claimed in the PCT case and therefore cannot determine whether the documents are appropriate. You did not provide a copy of the specification for the PCT application. Please send copies of all formal correspondence relating to the PCT application if you want to pursue the PCT matter further.

In addition, you should note that The Scripps Research Institute (TSRI) filed International Application No. PCT/US03/36195 that relates to the some of the same technology described in the above identified U.S. patent application. A copy of the PCT application filed by TSRI is enclosed for your information.

Notwithstanding the very helpful meeting held in February between TSRI and Salk to talk with the collaborators in this project, we believe that inventorship designated on PCT/US03/36195 is correct. Therefore, if you wish to pursue this matter, TSRI repeats its earlier requests to Dr. Silberstein that Salk consider using independent and mutually agreeable outside counsel to meet with the parties and make an independent assessment of inventorship in this matter.

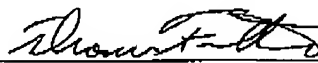
Judith Munoz, Ph.D.
April 6, 2004

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TSRI 918.0P

Please do not hesitate to contact me if you have any questions in this matter.

Very truly yours,



Thomas Fitting

TF:amf
Enclosures

cc: Gary Silberstain, Ph.D., Esq. (w/o encl.)
Sheila Kirschenbaum (w/o encl.)
Thomas Northrup, Esq., Associate General Counsel, TSRI (w/o encl.)

P:\ARIEL\2004\MISC\918.0P.Judith